

ESTTA Tracking number: **ESTTA656110**

Filing date: **02/16/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Texas A&M University
Granted to Date of previous extension	02/28/2015
Address	301 Tarrow Street, 6th Floor College Station, TX 77840 UNITED STATES
Attorney information	John C. Cain Wong, Cabello, Lutsch, Rutherford & Brucculeri, L.L.P. 20333 SH 249, Suite 600 Houston, TX 77070 UNITED STATES WCTrademark@Counselip.com, jcain@counselip.com Phone:832-446-2400

### Applicant Information

Application No	86355940	Publication date	12/30/2014
Opposition Filing Date	02/16/2015	Opposition Period Ends	02/28/2015
Applicant	Williams, Mahlon D. 8 Danville St West Roxbury, 02132 FRANCE		

### Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0  
All goods and services in the class are opposed, namely: Graphic T-shirts; Hooded sweatshirts

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	3354769	Application Date	01/12/2007
Registration Date	12/18/2007	Foreign Priority Date	NONE
Word Mark	12TH MAN		

Design Mark	12TH MAN
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 1922/00/00 First Use In Commerce: 1922/00/00 Entertainment services, namely conducting, organizing and promoting sporting events featuring football, soccer, baseball, softball, basketball, swimming, diving, equestrian, and tennis

U.S. Registration No.	1612053	Application Date	12/26/1989
Registration Date	09/04/1990	Foreign Priority Date	NONE
Word Mark	12TH MAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1984/09/00 First Use In Commerce: 1984/09/00 Bumper stickers, post cards and note cards Class 020. First use: First Use: 1984/09/00 First Use In Commerce: 1984/09/00 Novelty BUTTONS Class 024. First use: First Use: 1984/11/00 First Use In Commerce: 1984/11/00 Towels Class 025. First use: First Use: 1983/09/00 First Use In Commerce: 1983/09/00 Hats, t-shirts, polo-type shirts, golf shirts, sweaters, shorts, and athletic uniforms Class 036. First use: First Use: 1965/05/00 First Use In Commerce: 1965/05/00 College scholarship services		

U.S. Registration No.	1948306	Application Date	08/12/1994
Registration Date	01/16/1996	Foreign Priority Date	NONE
Word Mark	12TH MAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00 jewelry Class 041. First use: First Use: 1922/00/00 First Use In Commerce: 1922/00/00 entertainment services, namely organizing and conducting intercollegiate sport- ing events		

U.S. Registration No.	4301538	Application Date	10/21/2011
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Registration Date	03/12/2013	Foreign Priority Date	NONE
Word Mark	HOME OF THE 12TH MAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2006/12/31 First Use In Commerce: 2006/12/31 T-shirts Class 041. First use: First Use: 1988/12/31 First Use In Commerce: 1988/12/31 Arranging and conducting athletic competitions; Sport camps		

Attachments	76671314#TMSN.png( bytes ) 85977835#TMSN.png( bytes ) Notice of Opposition.pdf(313338 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/John C. Cain/
Name	John C. Cain
Date	02/16/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application  
Serial No. 86/355,940

Published in the Official Gazette  
on December 30, 2014

Texas A & M University,

Opposer,

v.

Mahlon D. Williams dba Fan Favorite, Inc.,

Applicant.

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Opposition No. \_\_\_\_\_

Mark: **12TH FAN**

**NOTICE OF OPPOSITION**

**BOX TTAB**

**FEE**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Madam:

Texas A&M University (“Texas A&M” or “Opposer”), a member of The Texas A&M University System, a Texas state institution of higher learning, having an address of 300 Tarrow Street, 6<sup>th</sup> Floor, College Station, Texas 77840, believes that it will be damaged by the registration by Mahlon D. Williams dba Fan Favorite, Inc. of the mark **12TH FAN** shown in Application Serial No. 86/355,940 in International Class 25 and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. Applicant seeks to register the mark **12TH FAN** as a mark for “graphic t-shirts; hooded sweatshirts” in International Class 25. The application to register the mark for such goods was filed on an intent-to-use basis. The application was published for opposition on December 30, 2014. The time for filing an opposition has been extended until Sunday February 28, 2015. Accordingly, the present Notice of Opposition is timely filed.
2. Since at least as early as 1922, Texas A&M has used the mark **12TH MAN** (hereinafter referred to sometimes as the “Mark”) in connection with sporting events and numerous products and services. The Mark was initially adopted in 1922 as a remembrance of E. King Gill and his spirit of readiness to serve Texas A&M’s football team in time of need. The legend of E. King Gill grew, and the Mark **12TH MAN** now identifies and distinguishes Texas A&M as the source for the athletic events and other services and various merchandise in connection with which Texas A&M and its licensees use the Mark. These products and services include, but are not limited to: sporting events, educational services, computer game software, towels, hats, shirts, athletic uniforms, jewelry, bumper stickers, and college scholarship services.
3. Texas A&M has expended considerable effort and expense in offering a wide range of quality products and services under the Mark. As a result, the Mark has become strongly identified by the public with Texas A&M, and Texas A&M enjoys substantial common law trademark rights and fame in the **12TH MAN** Mark.
4. Opposer is the owner of the following U.S. Registrations comprising or containing the mark **12TH MAN**:

Mark:		12TH MAN	
Reg. No.	Reg. Date	Class	Goods/Services
3,354,769	12/18/2007	41	Entertainment services, namely conducting, organizing and promoting sporting events featuring football, soccer, baseball, softball, basketball, swimming, diving, equestrian, and tennis
1,612,053	09/04/1990	16	Bumper stickers, post cards and note cards
		24	Towels
		25	Hats, t-shirts, polo-type shirts, golf shirts, sweaters, shorts, and athletic uniforms
		36	College scholarship services
1,948,306	01/16/1996	14	Jewelry
		41	Entertainment services, namely organizing and conducting intercollegiate sporting events
Mark:		HOME OF THE 12TH MAN	
4,301,538	03/12/2013	25	T-shirts
		41	Arranging and conducting athletic competitions; Sport camps

5. There is no issue as to priority. Opposer and its licensees have been using the mark **12TH MAN** in connection with a variety of goods and services, including hats, pants, t-shirts, sweatshirts, jackets, and other clothing, since well before Applicant's filing date, August 3, 2014.

6. On information and belief, Applicant is affiliated with Boston Sports Apparel Company, which has websites located at [www.ilovebostonsports.com](http://www.ilovebostonsports.com) and [www.thebostonsportscompany.com](http://www.thebostonsportscompany.com). The "About" page at ilovebostonsports.com states the following:

I promise you though that everything on this site is completely original and something unlike any other sports apparel site. Although we don't offer licensed sports apparel, we can say without question that our products are much more inspiring. We pride ourselves on creating fun, quality apparel and designs that not only speak to Boston Sports Fans, but can be appreciated by anyone that enjoys quality art.

Despite stating that it does not offer licensed sports apparel, numerous clothing items offered for sale at the website ilovebostonsports.com include derivations of famous

trademarks, including the following variations of the Air Jordan, Budweiser and Jack Daniel's marks:



7. Applicant's mark, **12TH FAN**, when used for the goods described in the application, so resembles Opposer's mark, **12TH MAN**, as to be likely to cause confusion, mistake, or deception, and as to be likely to dilute the distinctive quality of Opposer's **12TH MAN** mark.
8. If Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its mark for the goods described in its application. Such registration would be a source of damage and injury to Opposer.

Wherefore, Opposer prays that this Opposition be sustained and that the mark of Application Serial No. 86/355,940 be refused registration.

If the requisite filing fee associated with filing the present Notice of Opposition is inadvertently omitted, or the amount is insufficient, or should any additional fees under 37 C.F.R. § 2.6 be required for any reason relating to the present Notice of Opposition, or should an overpayment be included herein, the Commissioner for Trademarks is authorized to deduct or credit said fees from or to Wong Cabello Deposit Account No. 501922/1052-0413.

Please direct all communications concerning the referenced opposition proceeding to the following:

John C. Cain  
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Dated: 16 February 2015

Respectfully submitted,

By:



John C. Cain  
Attorney for Opposer  
Texas A&M University

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